

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

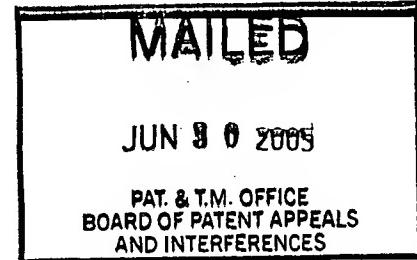
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte JAMES PRESCOTT CURRY

Appeal No. 2005-0509
Application No. 09/449,237

ON BRIEF



Before BARRETT, BARRY, and MACDONALD, *Administrative Patent Judges*.

MACDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 81-93 and 95-97. Claims 1-80 and 94 have been canceled.

Invention

Appellant's invention relates to a method and system that allows users to custom design interactive fitness, diet, and rehabilitation programs and purchase goods. The system and method includes at least one portal, a distributed network, and a controller or server. The portals are distributed to sponsors to provide distributed access to the controller. For example, a sponsored portal could be a kiosk placed in a health club, fitness center or shopping mall. An

authorized non-sponsored portal could be an authorized user's home computer. In operation, when a user connects to the controller, the controller initiates a validation sequence. The controller seamlessly accesses a record system or a database to identify the portal and the user. When the portal and the user are identified, the controller assigns an access code. Preferably, the access code defines the user's access rights that determine the level of services and discounts offered to the user. While the access code is being assigned, the controller may transparently access a payment database or a payment controller that retains records of user accounts receivable. If the user is delinquent, the controller can prompt the user to tender payment. Payment may then be tendered, for example, through credit cards, electronic fund transfer, debit cards, digital cash, vending systems, or other known electronic commerce methods.

Appellant's specification at page 2, lines 2-18.

Claim 81 is representative of the claimed invention and is reproduced as follows:

81. A method of providing wellness-related services, including at least one of wellness, health, or fitness services through a publicly accessible distributed network to authorized users using authorized portals, comprising:

providing an online site that enables wellness-related databases to be accessed from at least one of a sponsored and a non-sponsored portal;

placing in communication at least one of a sponsored and non-sponsored portal to the online site through the publicly accessible distributed network wherein the publicly accessible distributed network includes the Internet, wherein the sponsored portal is at least in part sponsored by and located at, a fitness center, and wherein at least one of the non-sponsored portals accesses the on-line site through the Internet;

receiving a request at the online site requesting access to the wellness-related databases;

processing the request at the online site to determine whether the portal was sponsored and whether the request was received from an authorized user; and

responding to the request based in part on whether the portal was sponsored and whether the user is authorized.

References

The references relied on by the Examiner are as follows:

Baker et al. (Baker)	5,678,041	Oct. 14, 1997
Roth	5,890,997	Apr. 6, 1999
Szabo	5,954,640	Sep. 21, 1999

Rejections At Issue

Claims 81 and 93 stand rejected under 35 U.S.C. § 103 as being obvious over Baker.

Claims 82-87, 90, and 95-97 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Baker and Szabo.

Claims 88, 89, 91 and 92 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Baker and Szabo and Roth.

Throughout our opinion, we make references to the Appellant's briefs, and to the Examiner's Answer for the respective details thereof.¹

¹ Appellant filed an appeal brief on October 8, 2003. Appellant filed a reply brief on June 4, 2004. The Examiner mailed an Examiner's Answer on April 2, 2004.

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellant and the Examiner, for the reasons stated *infra*, we affirm the Examiner's rejection of claims 81, 82, 85, and 93 under 35 U.S.C. § 103, and we reverse the Examiner's rejection of claims 83-84, 86-92, and 95-97 under 35 U.S.C. § 103.

Only those arguments actually made by Appellant have been considered in this decision. Arguments that Appellant could have made but chose not to make in the brief have not been considered. We deem such arguments to be waived by Appellant [see 37 CFR § 41.37(c)(1)(vii) effective September 13, 2004 replacing 37 CFR § 1.192(a)].

Appellant has indicated that for purposes of this appeal, the claims stand or fall together in twelve groupings. See page 5 of the brief. However, Appellant does not argue each group of claims separately and explain why the claims of each group are believed to be separately patentable. Rather, Appellant has repeated the same few arguments for multiple groups. See pages 6-18 of the brief and pages 2-4 of the reply brief. Appellant has not met the requirements of 37 CFR § 1.192 (c)(7) (July 1, 2002) as amended at 62 Fed. Reg. 53169 (October 10, 1997), which was controlling at the time of Appellant's filing of the brief. 37 CFR § 1.192 (c)(7) states:

Grouping of claims. For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the

group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

We will, thereby, consider Appellant's claims as standing or falling together in five groups based on the distinct rejections and arguments presented by Appellant, and we will treat:

Claim 81 as a representative claim of Group I (claims 81 and 93);

Claim 82 as a representative claim of Group II (claim 82);

Claim 85 as a representative claim of Group III (claim 85);

Claim 86 as a representative claim of Group IV (claims 83-84, 86-87, 90, and 95-97), and

Claim 88 as a representative claim of Group V (claims 88-89 and 91-92).

If the brief fails to meet either requirement, the Board is free to select a single claim from each group and to decide the appeal of that rejection based solely on the selected representative claim. *In re McDaniel*, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002). See also *In re Watts*, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004).

I. Whether the Rejection of Claims 81 and 93 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the invention as set forth in claims 81 and 93. Accordingly, we affirm.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellant. *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444. *See also Piasecki*, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument." *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of

record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." *In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

With respect to independent claim 81, Appellant argues at pages 6-11 of the brief, that the Examiner has erred in finding 1) the type of data in the database is nonfunctional descriptive material, 2) the physical location (a fitness center) where part of the method is performed is merely a field of use limitation, and 3) the sponsorship status of the portal is nonfunctional descriptive material. We note that Appellant also believes that the Examiner has read these limitations out of the claims and may believe that these limitations are merely business method limitations. On these two points we find nothing in the record before us to support Appellant's business method contention and rather than reading the limitations out of the claims, we find that the Examiner has addressed each of the three limitations listed above.

As to the type of data in the database, we find the Examiner's position to be the better. We find that the "wellness-related" data in the databases and communicated on the distributed network does not functionally change either the data storage system or communication system used in the method of claim 81. Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. *In re Ngai*, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004). Cf. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not

functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

Common situations involving nonfunctional descriptive material are:

- a computer-readable storage medium that differs from the prior art solely with respect to nonfunctional descriptive material, such as music or a literary work, encoded on the medium,
- a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or
- a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

Thus, if the prior art suggests storing a song on a disk, merely choosing a particular song to store on the disk would be presumed to be well within the level of ordinary skill in the art at the time the invention was made. The difference between the prior art and the claimed invention is simply a rearrangement of nonfunctional descriptive material.

As to the physical location (in a fitness center) being merely a field of use limitation, again we find the Examiner's position to be the better. We find that the claimed fitness center does not differ structurally from the school taught by Baker (column 1). We find that they differ solely based on their intended use. Appellant himself reinforces this in the specification at page 2, where he discloses the portal could be in either a fitness center or a shopping mall. Clearly, the fitness center and shopping mall are the same structurally and differ

only as to their intended uses. Statements of intended use do not serve to distinguish structure over the prior art. See *In re Pearson*, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974); *In re Yanush*, 477 F.2d 958, 959, 177 USPQ 705, 706 (CCPA 1973); *In re Casey*, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967).

As to the sponsorship status of the portal, again we find the Examiner's position to be the better. Appellant at page 8 of the specification states that sponsorship is related to location data including portal addresses and at page 3 states that users' access rights are adjusted according to their location. That is, portal addresses control access rights. As the Examiner has pointed out in the rejection, Baker teaches this at column 4. We find that Baker clearly teaches differing access rights based on location data including portal addresses. We find that the further labeling of a portal as sponsored or unsponsored does nothing to change the structure or functionality of the portal. We concur with the Examiner that this is nonfunctional descriptive material.

Finally, we note that while Baker teaches "authorized portals" (referred to as users or user terminals), Baker does not appear to have "authorized users" within the meaning of claim 81. However, authorization of individual users (as opposed to terminals) is such a pervasive concept in the art that we presume this is why Appellant did not argue it. Regardless, we deem this argument to be waived by Appellant as Appellant chose not to make the argument.

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 103.

II. Whether the Rejection of Claim 82 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the invention as set forth in claim 82. Accordingly, we affirm.

With respect to dependent claim 82, Appellant argues at page 14 of the brief, that neither reference teaches “fitness related data” as the data entered and accessed in the database. As we have discussed above with respect to claim 81, the type of data does not functionally change either the data storage system or communication system used in the method.

Therefore, we will sustain the Examiner’s rejection under 35 U.S.C. § 103.

III. Whether the Rejection of Claim 85 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the invention as set forth in claim 85. Accordingly, we affirm.

With respect to independent claim 85, Appellant repeats the arguments of claim 81 at pages 11-13 of the brief. We find these arguments unpersuasive for the reasons already discussed above with respect to claim 81.

Therefore, we will sustain the Examiner’s rejection under 35 U.S.C. § 103.

IV. Whether the Rejection of Claims 83-84, 86-87, 90, and 95-97 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 83-84, 86-87, 90, and 95-97. Accordingly, we reverse.

With respect to independent claim 86, Appellant argues at page 13 of the brief, "Szabo discusses adaptive models for users already in groups, not automatically assigning users to groups based on user attributes." We have reviewed the references, and we agree with Appellant. We find that the second assigning step of claim 86 is not reasonably taught by the references. Therefore, the Examiner has not met the initial burden of establishing a *prima facie* case of obviousness and we will not sustain the Examiner's rejection under 35 U.S.C. § 103.

V. Whether the Rejection of Claims 88-89 and 91-92 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 88-89 and 91-92. Accordingly, we reverse.

With respect to dependent claims 88-89 and 91-92, we note that the Examiner has relied on the Roth reference solely to teach "workout guidelines

and advise" (answer at page 10). The Roth reference in combination with the Baker and Szabo patents fails to cure the deficiencies of Baker and Szabo noted above with respect to claim 86. Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103 for the same reasons as set forth above.

Conclusion

In view of the foregoing discussion, we have sustained the rejection under 35 U.S.C. § 103 of claims 81, 82, 85, and 93, and we have not sustained the rejection under 35 U.S.C. § 103 of claims 83-84, 86-92, and 95-97.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

Lee E. Barrett
LEE E. BARRETT)
Administrative Patent Judge)
)

Lance Leonard Barry
LANCE LEONARD BARRY)
Administrative Patent Judge)
)

Allen R. Macdonald
ALLEN R. MACDONALD)
Administrative Patent Judge)

) BOARD OF PATENT
) APPEALS AND
) INTERFERENCES

INTELLECTUAL PROPERTY GROUP
FREDRIKSON & BYRON, P.A.
200 SOUTH SIXTH STREET
SUITE 4000
MINNEAPOLIS, MN 55402